



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,346	01/18/2002	Bruce B. Fitts	RGP-0072	9834
23413	7590	12/30/2004		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER LE, HOA VAN	
			ART UNIT 1752	PAPER NUMBER

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,346

Applicant(s)

FITTS ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004 and 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) (1-10), (11-16), (17-39), (40-60), (61), (62), (63-75), (76), (77-89) and (90) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are (1-10), (11-16), (17-39), (40-60), (61), (62), (63-75), (76), (77-89) and (90) .

Art Unit: 1752

This is in response to Papers filed on 12 October and 08 November 2004.

- A. On 28 December 2004 a telephone call was made to the Office of Ms. Mary Golota because she requests an interview. However, she was not at he desk. She may call in the Office anytime.
- B. The record shows that the broadest independent claim 1 was independently considered and searched only. Others are integrally considered and searched to those in claim 1.
- C. On 12 October 2004 applicants amend some independent claims and urge that they patentably different and distinct from the others.
- D. In view of the arguments, the restriction is made. Each of independent claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-75), (76), (77-89) and (90) will be independently considered and searched as urged on the record.
- E. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-75), (77-89) and (90)
drawn to a material, classified in class 429, class 26
 - II. Claim 76, drawn to a method, classified in class 264, subclass 5+. No search in these class and subclass was made on the record. Their embodiments were

Art Unit: 1752

integrally picking up during the searches in class 429 only. If applicants elect this invention, the application may be transferred.

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as providing as second coating layer instead of using a molding process. Applicants should show or provide evidence to the contrary. In the absence of convincing, the restriction on the record would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination purposes as indicated is proper. Applicant should show or provide evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

However any process claim is permitted to be rejoined with an elected material claimed invention provided (a) that the material claimed invention is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

Art Unit: 1752

F. The independent groups of material claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-75), (77-89) and (90) are not considered patentably different or distinct invention since they share the general shape with some species variant. Therefore, no restriction among them is made. Should applicants disagree, show or urge otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as shown or urged.

Claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-75), (77-89) and (90) are generic to a plurality of disclosed patentably distinct species comprising:

- species number 1 with respect to the group of claims (1-10),
- species number 2 with respect to the group of claims (11-16),
- species number 3 with respect to the group of claims (17-39),
- species number 4 with respect to the group of claims (40-60),
- species number 5 with respect to the group of claim (61),
- species number 6 with respect to the group of claim (62),
- species number 7 with respect to the group of claims (63-75),
- species number 8 with respect to the group of claims (77-89),
- species number 9 with respect to the group of claim (90),

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species number such as 1 or 2, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 1752

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

G. Applicant is advised that the reply to this requirement to be complete must include full elections and requirements to be examined even though the requirement be traversed (37 CFR 1.143).

H. Other issues have not been considered until full and proper elections and requirements are made and resolved.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1752

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
28 December 2004

HOA VAN LE
PRIMARY EXAMINER
